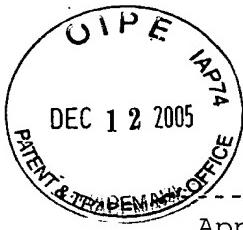


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6715/57089



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Han Min-Jae

Serial No. : 09/319,093

Filed : August 16, 1999 Appeal No.

For : RECORD/PLAYBACK APPARATUS AND
RECORD/PLAYBACK METHOD

Group : 3621

Examiner : John W. Hayes

I hereby certify that this paper is being deposited with the U.S. Postal Service as first class mail addressed to : Mail Stop Appeal Brief, Commissioner for Patents, P.O. 1450, Alexandria, VA 22313-1450

JAY H. MAIOLI Date
Reg. No. 27,213 December 7, 2005

December 7, 2005
1185 Avenue of the Americas
New York, NY 10036
(212) 278-0400

TRANSMITTAL LETTER FOR APPELLANT'S AMENDED BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted in triplicate is Appellant's Amended Appeal Brief in the above-identified application.

The fee of \$500.00 set by 37 C.F.R. § 41.20(b) for

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filing the Brief has already been submitted on March 9, 2005 along with Appellant's original appeal brief and it is believed that no additional fees are required at this time. However, in the event that additional fees are required, please charge any additional fees incurred by reason of the Brief or credit any overpayment to Deposit Account No. 03-3125. A duplicate of this Transmittal Letter is enclosed.

Respectfully submitted,

COOPER & DUNHAM LLP



Jay H. Maioli
Reg. No. 27,213

JHM/JBG
enc.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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New York, NY 10036
(212) 278-0400

APPELLANT'S AMENDED APPEAL BRIEF IN RESPONSE TO
NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF (37 CFR 41.37)

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Notification of Non-Compliant Appeal Brief (37 CFR 41.37) (a copy of which is enclosed herewith), the Appellant submits this Amended Appeal Brief.

This is an Appeal to the Board of Patent Appeals and Interferences from the Decision dated January 11, 2005, of the Examiner finally rejecting claims 1-18 pending in this application.

1. REAL PARTY IN INTEREST

This application is assigned to Sony Corporation, 7-35 Kitashinagawa 6-chome, Shinagawa-ku, Tokyo 141, Japan by the Assignment recorded August 16, 1999 at Reel 010187, Frame 0469.

2. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences presently known to the undersigned.

3. STATUS OF CLAIMS

This application was originally filed with 44 claims. Claims 1-44 were amended by the Preliminary Amendment mailed January 20, 2000. Claims 1, 5-7, 11, 18, 19, 23, 31, 41, 42 and 44 were amended and new claim 45 was added by the Amendment mailed November 12, 2001. Claims 1, 8, 11, 19, 23, 31, 38, 41, and 45 were amended by the Amendment mailed June 20, 2002, and amended again by the Amendment mailed December 11, 2002. Claims 19-45 were cancelled and claims 1 and 11 amended by the Amendment mailed April 10, 2003. Claims 1 and 11 were amended by the Amendment mailed October 30, 2003, and amended again by the

Amendment mailed March 26, 2004. Claims 1 and 11 were further amended by the Amendment mailed September 2, 2004. A Final Office Action was mailed on January 11, 2005 finally rejecting claims 1-18. Claims 1-18 stand finally rejected and are the basis of this Appeal.

4. STATUS OF AMENDMENTS

A Final Office Action was mailed on January 11, 2005 finally rejecting claims 1-18. Claims 1-18 stand finally rejected and are set forth in The Claims Appendix attached hereto.

5. SUMMARY OF CLAIMED SUBJECT MATTER

The invention presently claimed in independent claim 1 relates to a record/playback apparatus including:

a record/playback unit configured to read out data from a first recording medium (15 in Fig. 1) and recording the data onto a second recording medium (16 in Fig. 1);

a control unit (13 in Fig. 1) configured to generate basic data (13B in Fig. 1) for imposing payment based on a copyright holder ID read from a control data storage region (TOC) of the first recording medium (Page 9, lines 3-9, and output of 13 in Fig. 1), data indicative of a user identification, and data indicative of a dubbing speed selected by the user (page 10, lines 1-13, and output of 13 in Fig. 1) for recording the data

read out from the first recording medium (15 in Fig. 1) onto the second recording medium (16 in Fig. 1) and configured to transmit the basic data for imposing payment (14 in Fig. 1), and when receiving data indicative of proper completion of imposing payment (page 15, lines 8-13), configured to cause the record/playback unit to start the recording of the data read out from the first recording medium (15 in Fig. 1) onto the second recording medium (16 in Fig. 1) at the dubbing speed selected by the user (page 12, lines 6-13); and

a payment imposing unit (20 in Fig. 1) configured to determine, when receiving the basic data for imposing payment transmitted by the control unit (step S2 in Fig. 2) an amount of payment based on the dubbing speed selected by the user and the copyright holder ID (steps S3 and S4 in Fig. 2), and configured to transmit to the control unit the data indicative of proper completion of imposing payment (step S5 in Fig. 2) when an electronic transfer of funds equal to the determined amount of payment is withdrawn from an account of the user and transferred to an account specified by the copyright holder ID (page 11, line 20 to page 12, line 3),

wherein the control unit (13 in Fig. 1) causes, when the dubbing speed is a standard dubbing speed, the record/playback unit to start the recording of the data read out from the first recording medium (15 in Fig. 1) onto the second recording medium (16 in Fig. 1) at the standard dubbing speed

without transmitting the basic data to the payment imposing unit (page 27, lines 12-21).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-18 are patentable under 35 U.S.C. § 103(a) over Ball et al. in view of Suzuki, Yoshioka, Freeny, Jr., and Endoh.

7. ARGUMENT

CLAIMS 1-18 ARE PATENTABLE UNDER 35 U.S.C. § 103(a) OVER BALL ET AL. IN VIEW OF SUZUKI, YOSHIOKA, FRENNY, JR., AND ENDOH

As described above in the "SUMMARY OF THE CLAIMED SUBJECT MATTER" section of this Brief, features of the claimed invention are a payment imposing unit wherein a payment imposed upon a user is based in part on a dubbing speed selected by the user, a control unit for starting the dubbing at a standard dubbing speed without transmitting basic data for imposing unit, the payment imposing unit transferring a payment collected to an account specified by the copyright holder, and the control unit reading a copyright holder ID from a TOC area of a first recording medium.

It is respectfully submitted that the combination of Ball et al., Suzuki, Yoshioka, Freeny, Jr., and Endoh fails to show or suggest the above-noted features of the present invention

for the following reasons.

The Examiner concedes that Ball et al. fails to show or suggest a payment imposing unit wherein a payment imposed upon a user is based in part on a dubbing speed selected by the user and cites Suzuki as curing this deficiency.

It is respectfully submitted that Suzuki fails to show or suggest a payment imposing unit wherein a payment imposed upon a user is based in part on a dubbing speed selected by the user.

Suzuki relates to an information providing apparatus that manages a transmission band of a transmission line and charges a user depending on a data compression rate and on a wait period for receiving the data. See Fig. 6, and col. 6, lines 43-59 of Suzuki, for example.

It is respectfully submitted that it would not have been obvious to combine Suzuki with Ball et al. because the art of managing a transmission band of a transmission line would not be investigated by an inventor designing a dubbing system connected to a payment imposing unit.

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1972), citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is further established that

"[s]uch a suggestion may come from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem." Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), citing In re Rinehart, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (considering the problem to be solved in a determination of obviousness). The Federal Circuit reasons in Para-Ordnance Mfg., Inc. v. SGS Importers Int'l, Inc., 73 F. 3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir. 1995), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellant.

In addition, the Federal Circuit requires the Office to make findings on a suggestion to combine prior art references. In re Dembicza, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-18 (Fed. Cir. 1999). The Federal Circuit states further that the "factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority." In re Lee, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock,

Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

Assuming, arguento, that Suzuki could be combined with Ball et al., the combination would still fail to show or suggest a payment imposing unit wherein a payment imposed upon a user is based in part on a dubbing speed selected by the user. Suzuki is merely charging a user based on the data compression rate and on a wait period for receiving the data.

Further, the Examiner concedes that Ball et al. fails to show or suggest a control unit for starting the dubbing speed at a standard dubbing speed without transmitting basic data for imposing payment to the payment imposing unit and cites Yoshioka as curing this deficiency.

Yoshioka relates to a dubbing unit wherein the dubbing can be carried out at a standard dubbing speed or at a fast dubbing speed in response to a switch position, see col. 5, lines 3-21 of Yoshioka, and is silent about charging anything for the dubbing, therefore, the system of Yoshioka does not include a payment imposing unit. For at least this reason, it is respectfully submitted that it would not have been obvious to combine Yoshioka with Ball et al. and that Yoshioka teaches away from the presently claimed invention due to the lack of a payment imposing unit.

Furthermore, the Examiner concedes that Ball et al. fails to show or suggest the payment imposing unit transferring a payment collected to an account specified by the copyright holder

and cites Freeny, Jr. as curing this deficiency.

Freeny, Jr. relates to a system for reproducing information by requesting reproduction codes at a point of sale location, see col. 13, lines 27-36 of Freeny, Jr., and is silent about transferring a payment to an account specified by the copyright holder. In Freeny, Jr. it is the point of sale location owner who charges the credit card of the user.

Finally, the Examiner concedes that Ball et al. fails to show or suggest the control unit reading a copyright holder ID from a control data storage region (TOC) of a first recording medium and cites Endoh as curing this deficiency.

Endoh relates to a recording control apparatus wherein the user purchases a point tape having a point area for restricting a time during which a copy can be made. See col. 3, lines 31-34, and col. 4, lines 56-58 of Endoh.

It is respectfully submitted that the points in the point area of Endoh are unrelated to a copyright holder ID and that the point area of Endoh is unrelated to the control data storage region (TOC) according to the presently claimed invention.

Accordingly, it is respectfully submitted that claims 1-18 are patentable under 35 U.S.C. § 103(a) over Ball et al. in view of Suzuki, Yoshioka, Freeny, Jr., and Endoh.

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A reversal of the Final Rejection of claims 1-18 by
this Honorable Board is respectfully requested.

Respectfully submitted,
COOPER & DUNHAM LLP


Jay H. Maioli
Reg. No. 27,213

JHM/JBG

8. CLAIMS APPENDIX

Claim 1. A record/playback apparatus comprising:

a record/playback unit configured to read out data from a first recording medium and recording the data onto a second recording medium;

a control unit configured to generate basic data for imposing payment based on a copyright holder ID read from a control data storage region (TOC) of the first recording medium, data indicative of a user identification, and data indicative of a dubbing speed selected by the user for recording the data read out from the first recording medium onto the second recording medium and configured to transmit the basic data for imposing payment, and when receiving data indicative of proper completion of imposing payment, configured to cause the record/playback unit to start the recording of the data read out from the first recording medium onto the second recording medium at the dubbing speed selected by the user; and

a payment imposing unit configured to determine, when receiving the basic data for imposing payment transmitted by the control unit an amount of payment based on the dubbing speed selected by the user and the copyright holder ID, and configured to transmit to the control unit the data indicative of proper completion of imposing payment when an electronic transfer of funds equal to the determined amount of payment is withdrawn from an account of the user and transferred to an account

specified by the copyright holder ID,

wherein the control unit causes, when the dubbing speed is a standard dubbing speed, the record/playback unit to start the recording of the data read out from the first recording medium onto the second recording medium at the standard dubbing speed without transmitting the basic data to said payment imposing unit.

Claim 2. The record/playback apparatus according to claim 1, wherein the payment imposing unit includes a key data generator for generating key data as the data indicative of the completion of imposing payment from the received basic data.

Claim 3. The record/playback apparatus according to claim 2, wherein the control unit judges whether the key data received from the payment imposing unit as the data indicative of completion of imposing payment is authentic and controls operation of the record/playback unit with a result of the judgment.

Claim 4. The record/playback apparatus according to claim 3, wherein the control unit collates the key data received from the payment imposing unit as the data indicative of completion of imposing payment with key lock data stored therein and, when it is found from the collation that the key data is authentic,

directs the record/playback unit to start the recording of the data read out from the first recording medium onto the second recording medium.

Claim 5. The record/playback apparatus according to claim 4, wherein the control unit, when the key data is judged authentic, directs the record/playback unit in response to the data indicative of a speed to record the data read out from the first recording medium onto the second recording medium.

Claim 6. The record/playback apparatus according to claim 2, wherein the payment imposing unit, when the data indicative of a speed in the basic data received from the control unit is indicative of reading out data from the first recording medium and recording the data read out from the first recording medium onto the second recording medium at a predetermined speed, cancels imposing payment and generates the key data.

Claim 7. The record/playback apparatus according to claim 6, wherein the payment imposing unit, when the data indicative of a speed in the basic data received from the control unit is indicative of reading out data from the first recording medium and recording the data read out from the first recording medium onto the second recording medium at a speed faster than the standard speed, imposes payment and generates the key data.

Claim 8. The record/playback apparatus according to claim 1, further comprising:

an operating unit connected to the control unit; and
a data storage unit where a plurality of data is stored,
wherein the control unit reads out corresponding data from the
data storage unit in response to indicator data supplied in
response to an information input from the operating unit and
directs the record/playback unit to record the data read out from
the data storage unit onto the first recording medium.

Claim 9. The record/playback apparatus according to claim 1, wherein the payment imposing unit is connected via a communications line to the control unit.

Claim 10. The record/playback apparatus according to claim 1, wherein the payment imposing unit is connected via a communications line to the control unit.

Claim 11. A record/playback method of reading out data from a first recording medium and recording the data onto a second recording medium with the use of an apparatus capable of reading out the data from the first recording medium and recording the data onto the second recording medium, the method comprising the steps of:

generating basic data for imposing payment based on a

copyright holder ID read from a control data storage region (TOC) of the first recording medium, data indicative of a user identification, and data indicative of a dubbing speed selected by the user for recording the data read out from the first recording medium onto the second recording medium;

transmitting the basic data for imposing payment from the apparatus to a payment imposing unit;

imposing payment according to the basic data for imposing payment received, with an amount of payment determined based on the dubbing speed selected by the user, the copyright holder ID, and the user identification and for generating data indicative of proper completion of imposing payment when an electronic transfer of funds equal to the determined amount of payment is withdrawn from an account of the user in the payment imposing unit and transferred to an account specified by the copyright holder ID;

transmitting the data indicative of the proper completion of imposing payment from the payment imposing unit to the apparatus; and

controlling the apparatus to start recording the data read out from the first recording medium onto the second recording medium at the dubbing speed selected by the user in response to the data indicative of the proper completion of imposing payment,

wherein the controlling step includes controlling the apparatus to start the recording of the data read out from the first recording medium onto the second recording medium at a

standard dubbing speed without transmitting the basic data to the payment imposing unit when the dubbing speed is the standard dubbing speed.

Claim 12. The record/playback method according to claim 11 further comprising the step of:

generating key data using the payment imposing unit as the data indicative of the completion of imposing payment from the basic data received.

Claim 13. The record/playback method according to claim 12 further comprising the steps of:

judging whether the key data received as the data indicative of the completion of imposing payment is authentic; and

recording the data onto the second recording medium based on the judging.

Claim 14. The record/playback method according to claim 13, further comprising the steps of:

collating the key data received as the data indicative of the completion of imposing payment with key lock data held within the apparatus to judge the authenticity of the key data; and

recording the data read out from the first recording medium onto the second recording medium when the key data is judged authentic.

Claim 15. The record/playback method according to claim 14 further comprising the steps of:

recording the data onto the second recording medium according to the data indicative of a speed when the key data is judged authentic.

Claim 16. The record/playback method according to claim 12 further comprising the steps of

canceling imposing payment and generating the key data when the data indicative of a speed in the basic data received is indicative of reading out the data from the first recording medium and recording it onto the second recording medium at a predetermined speed.

Claim 17. The record/playback method according to claim 16 further comprising the steps of:

imposing payment and generating the key data when the data indicative of a speed in the basic data received from the control unit is indicative of reading out data from the first recording medium and recording the read-out data onto the second recording medium at a speed faster than the predetermined speed.

Claim 18. The record/playback method according to claim 11 further comprising the step of:

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reading out corresponding data from a data storage unit in response to indicator data supplied from an operating unit and recorded onto the first recording medium.

9. EVIDENCE APPENDIX

There was no evidence submitted pursuant to 37 C.F.R
1.130, 1.131, or 1.132.

10. RELATED PROCEEDINGS AND APPENDIX

There are no related proceedings or decisions.

Notification of Non-Compliant Appeal Brief (37 CFR 41.37)	Application No. 09/319,093	DEC 12 2005 U.S. PATENT & TRADEMARK OFFICE	Applicant(s) HAN, MIN-JAE
	Examiner Kambiz Abdi	Art Unit 3621	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 14 March 2005 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within ONE MONTH or THIRTY DAYS from the mailing date of this Notification, whichever is longer. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.

1. The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. Other (including any explanation in support of the above items):

Please refer to the attached Order to Return from the Board of Patent Appeals and Interferences dated November 7, 2005.

11-9-07